

REMARKS

In view of the following remarks, the Examiner is requested to withdraw the rejections and allow Claims 17 and 19-37, the only claims pending and currently under examination in this application.

Claims 17 and 29 have been amended for clarity as requested by the Examiner. Support for these amendments may be found in the claims as originally presented and in the specification from line 11 on page 9 to line 22 on page 10.

As no new matter is added by way of these amendments, entry of the amendments by the Examiner is respectfully requested.

Claim Rejections - 35 USC § 102 Gamble

Claims 17, 18, 20-23, 25, 26, 28, 29-31, 33-34, 36 and 37 are rejected under 35 U.S.C. 102 (a or e) as being anticipated by Gamble et al. (US Patent No. 6,001,309). The Applicants traverse this rejection.

The standard for anticipation under section 102 is one of strict identity. An anticipation rejection requires a showing that each limitation of a claim be found in a single reference.¹ To anticipate a claim, a prior art reference must disclose every feature of the claimed invention, either explicitly or inherently.²

Although the Applicants contend that the claims are clear with regard to the relationship between dispensers and feature deposition, Applicants have amended Claims 17 and 29 for clarity. These amendments are made solely to expedite prosecution of the present application.

As argued below, the Applicants submit that Gamble does not disclose each and every element of the rejected claims. Specifically, Gamble does not teach the deposition of a first feature set from a first dispenser and a second feature set from a second dispenser. Gamble also does not teach the element of depositing of multiple feature sets, where the distance between two neighboring sets of features is greater than an average distance between features within the feature sets, both as

¹ *Atlas Powder Co. v. E.I. DuPont de Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

² *Glaxo v. Novopharm, Ltd.* 334 U.S. P.Q.2d 1565 (Fed. Cir. 1995).

measured in a same direction. These elements are present in all rejected claims.

In making this rejection, the Examiner cites columns 9 and 12 in Gamble as allegedly anticipatory. However, a detailed analysis of the cited passages reveals that Gamble merely discloses concurrent or consecutive deposition of spots by using groups of jets. Nowhere in Gamble is there an element of multiple feature sets as recited in the rejected claims, in which a first feature set is deposited from a first dispenser and a second feature set from a second dispenser.

In attempting to establish the rejection, the Examiner further asserts that Gamble discloses that there is an advantage to include 2-3x redundancy as allegedly equivalent to the multiple feature sets in the instant claims, by citing column 12, lines 26-28.

However, this claimed element as depicted in an embodiment illustrated by Figure 4, copied below, is not disclosed by Gamble. Specifically, the claim limitation recites "a distance between at least two neighboring sets of features is greater than an average distance between features within the sets, both as measured in a same direction."

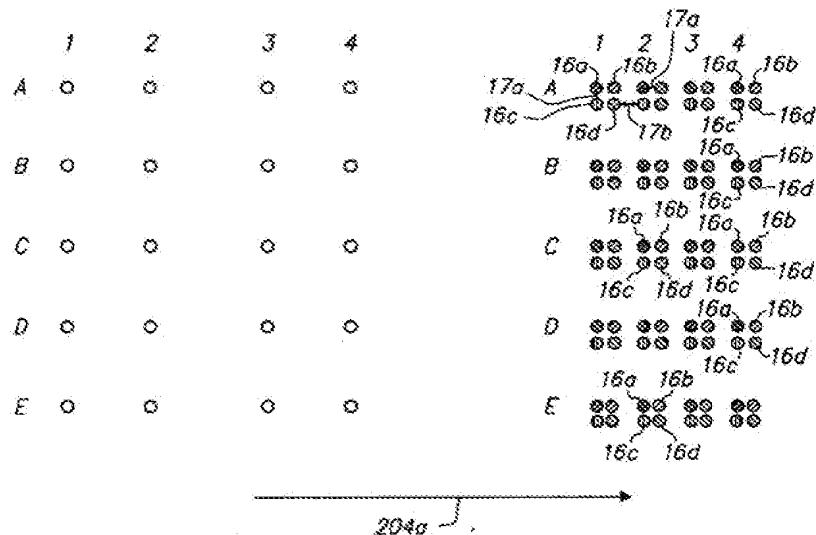


FIG. 4

The distance between two neighboring sets of features is represented by line 17b which connects feature 16d of region A1 with feature 16c of region A2. The distance between features within the sets is represented by line 17a which connects

features 16a and 16b of region A2. As claimed, line 17b is greater than line 17a which is measured in the same direction.

Column 12, lines 26-28 of Gamble merely states that “there is an advantage to include 2-3x redundancy in favor of accuracy and reliability.” Disclosing 2-3x redundancy does not teach the deposition of neighboring sets of features as claimed. The Applicants submit that the figure provided by the Examiner on page 6 of the Office Action dated 2/7/08 does not reflect the disclosure of Gamble when Gamble is read in context and analyzed as a whole. Contrary to the assertion of the Examiner, Gamble teaches that the distance between two neighboring sets of features is not greater than distance between features within the sets, or within the redundant spots, as interpreted by the Examiner to be equivalent to the feature sets recited in the rejected claims. This is apparently clear when Gamble analyzes the jetting time and distance of scans in column 13, lines 49-59. The calculation takes into account redundant spots on 4 different lines but assigns the same distance for all lines. Therefore, if Gamble teaches anything about the feature arrangement on the substrate, it is that the features are uniformly spaced on the substrate. As such, Gamble does not teach “a distance between at least two neighboring sets of features [to be] greater than an average distance between features within the sets.”

In view of the foregoing discussion, because Gamble et al. fail to teach all of the elements of the subject claims, Claims 17, 20-23, 25, 26, 28, 29-31, 33-34 are not anticipated by 35 U.S.C. 102 (a or e), and this rejection may be withdrawn.

Rejections - 35 USC § 103 Gamble and Suovaniemi

Claims 17, 18, 20-23, 25, 26, 28, 29-31, 33-34 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gamble et al. (US Patent No. 6,001,309) in view of Suovaniemi et al. (US Patent No. 4,215,092).

In order to meet its burden in establishing a rejection under 35 U.S.C. § 103 the Office must at least demonstrate that the combined prior art references teach or suggest all the claimed limitations.³ "The burden falls on the patent challenger to show by clear and convincing evidence that a person of ordinary skill in the art would

³ Federal Register vol. 72, No. 195, Oct 10, 2007. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)

have had reason to attempt to make [every element of] the composition or device, or carry out the [entire] claimed process, and would have had a reasonable expectation of success in doing so."⁴

As reviewed above, Gamble fails to teach at least the claimed element of a first feature set and a second feature set deposited by a first and second dispenser, respectively, and the element of the distance between at least two neighboring sets of features is greater than an average distance between features within the sets, both as measured in the same direction.

Because Gamble teaches no feature sets as recited in the rejected claims but only redundant spots, there is no deposition of first feature set from a first dispenser and of a second feature set from a second dispenser. Since Gamble is completely silent regarding this claim limitation, it cannot suggest this subject matter in the rejected claims either. In addition, Gamble fails to suggest the element of distance between two neighboring sets because, if Gamble does suggest anything, it suggests uniform feature spacing, as discussed previously. For example, in column 13, lines 49-59, Gamble assigns the same distance to all in the lines scanned by the dispenser.

Because Suovaniemi is cited solely for teaching a multi-channel pipette, Suovaniemi fails to make up for the fundamental deficiencies in Gamble.

Accordingly, Claims 17, 20-23, 25, 26, 28, 29-31, 33-34 and 19 are not obvious under 35 U.S.C. 103(a) over Gamble in view of Suovaniemi and this rejection may be withdrawn.

Claim Rejections - 35 USC § 103 Gamble and Bass

Claims 17, 20-26, 28, and 29-37 were rejected under 35. U.S.C. 103 (a) as being unpatentable over Gamble et al. (US Patent No. 6,001,309) in view of Bass (US Patent No. 6,420,180). The Applicants traverse this rejection.

As stated above, a *prima facie* case of obviousness requires at least a showing that all claimed elements are taught or suggested by the cited art. As discussed above, Gamble does not teach or suggest deposition of a first feature set

⁴ See, for example, *Pharmastem Therapeutics v. Viacell et al.*, 2007 U.S. App. LEXIS 16245 (Fed. Cir. 2007), citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007)

by a first dispenser and a second feature set by a second dispenser. Neither does it teach or suggest a distance between two neighboring sets to be greater than an average distance between features within the first and second sets.

As Bass is cited solely for teaching a manner of compensating for displacement errors, Bass fails to make up for the fundamental deficiencies in Gamble.

Accordingly, a *prima facie* case of obviousness has not been established and the Applicants respectfully request the withdrawal of this rejection.

CONCLUSION

In view of the remarks above, the Applicants respectfully submit that all of the Claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Ping Hwung at (408) 553-3738.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078 order number 10003513-2.

Respectfully submitted,

Date: May 5, 2008

By: /David C. Scherer, Reg. No. 56,993/

David C. Scherer, Ph.D.

Registration No. 56,993

Date: May 5, 2008

By: /Bret E. Field, Reg. No. 37,620/

Bret E. Field

Registration No. 37,620

PHR/DCS

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

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